

REMARKS

Applicants submit this Reply in response to the Final Office Action mailed March 26, 2010. Prior to this Amendment, claims 15-24 were submitted for examination. By this Reply, Applicants have amended claims 15, 16, and 24 and have canceled claim 21 without prejudice or disclaimer. Thus, claims 15-20 and 22-24 are submitted for examination, of which claim 15 is the sole independent claim. No new matter has been added.

In the Final Office Action, the Examiner alleged that the oath or declaration is defective; rejected claims 21 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; objected to claim 21 on the grounds of double patenting in view of independent claim 15; and rejected claims 15-22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over WO 03/078338 ("Jakobsen") in view of U.S. Patent Publication No. 2004/0237585 ("Fogliani").

By this Reply, Applicants have amended independent claim 15 to recite, in part:

A method of producing a holey optical fiber preform, comprising . . .
before consolidation of the porous preform, forming a pattern of
holes extending through the porous preform along the longitudinal
direction, wherein said pattern of holes is formed by drilling the
porous preform.

Support for this amendment can be found in Applicants' specification at least at page 7, lines 14-20 and page 8, lines 21-23.

Applicants respectfully note that "the subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement" of 35 U.S.C. § 112, first paragraph.

M.P.E.P. § 2163.02. Further, “[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible.” M.P.E.P. § 2163.07.

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

Objection to Oath/Declaration

In the Office Action, the Examiner objected to Applicants’ oath or declaration, asserting that the specification to which the oath or declaration is directed has not been adequately identified. Specifically, the Examiner asserts, “The declaration refers to two specifications. Examiner understands that a proper declaration must be directed to a single specification.” Office Action at 2. Applicants respectfully traverse the objection to the Declaration.

As noted in Applicants’ response to the Office Action dated November 10, 2009, Applicants believe the Examiner’s objection to the Declaration is unwarranted. Pursuant to 37 C.F.R. 1.497(a) and (b), Applicants are required to submit a declaration identifying the application by the international application number and international filing date. Accordingly, Applicants submitted a declaration on January 25, 2007, identifying the present application by its international filing data: PCT International Application No. PCT/EP2003/007157 filed June 30, 2003. The declaration also identifies the international application as having been filed and amended in this country in the national stage on December 29, 2005. By identifying the present application by its PCT international application data and by its filing date for this national stage, Applicants’ declaration is directed to a “single specification,” as sought by the Examiner, and has

met all the requirements of 35 U.S.C. § 371. Thus, Applicants believe the previously filed declaration is proper, and no new oath or declaration should be required.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the declaration.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 21 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, with respect to claim 21, the Examiner stated, "It is unclear if claim 21 is cancelled, because the text is still present and because claim 24 depends on claim 21." Office Action at 2.

By this Reply, Applicants have deleted the text of claim 21 and amended claim 24 to depend from "any one of claims 15 to 20 or 22 to 23."

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 21 and 24 under § 112, second paragraph.

Double Patenting Objection

In the Office Action, the Examiner objected to claim 21 on the grounds that, "should claim 15 be found allowable, claim 21 [would be] a substantial duplicate thereof." Office Action at 2.

However, by this Reply, Applicants have canceled claim 21. Thus, the Examiner's concern is moot.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the double patenting objection to claim 21.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner rejected claims 15-22 and 24 as being unpatentable over Jakobsen in view of Fogliani. Applicants respectfully traverse this rejection because the Office Action has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must disclose all of the claim limitations, or the claim rejection must explain why the differences between the prior art and the claim limitations would have been obvious to one of ordinary skill in the art. See M.P.E.P. § 2141.

A *prima facie* case of obviousness has not been established because, among other things, neither Jakobsen or Fogliani, alone or in combination, teaches or renders obvious every feature of Applicants' claims. Specifically, neither reference cited by the Examiner teaches or renders obvious at least, "before consolidation of the porous preform, forming a pattern of holes extending through the porous preform along the longitudinal direction, wherein said pattern of holes is formed by drilling the porous preform," as recited in amended independent claim 15.

In the Office Action, the Examiner asserts, "Jakobsen teaches the invention as claimed, except for the density." Office Action at 3. The only substantive support the Examiner provides for this assertion can be found in the previous Office Action dated November 10, 2009 where the Examiner rejected independent claim 15 under 35 U.S.C. § 102(e) based on Jakobsen. There, the Examiner argues, "See figure 2 of Jakobsen and [0005] and [0058] which disclose drilling a hole into a preform which already has holes. Drilled holes can be considered to be 'pores' Since the

Jakobsen preform has pores, it is a 'porous preform' prior to the last hole being drilled." Office Action dated November 10, 2009 at 4. However, the Examiner mischaracterizes Applicants' claim language, particularly the term "porous preform."

The term "porous preform," as understood by one of ordinary skill in the art, is a term used to describe the glass soot bodies formed during, for example, a flame hydrolysis process, prior to submitting the body to consolidation whereby the body is vitrified and becomes more dense. Applicants' specification explains, with respect to one exemplary embodiment:

The Applicant has realized that the holes can be formed rather easily by drilling the relatively soft glass soot bodies that are obtained from known soot processes, before submitting them to consolidation. This is much easier, much faster, and also better from the viewpoint of the results than drilling holes into a vitrified rod. . . . [Applicants'] method further comprises submitting the porous preform to a consolidation process after said drilling, thereby the density of the porous preform is increased.

Specification at page 7, lines 14-20 and page 8, lines 21-23 (emphasis added).

Jakobsen nowhere appears to teach or suggest drilling "at least one hole extending through the porous preform," as that term is understood by one of ordinary skill in the art. Rather, Jakobsen describes only a process whereby elongated channels are formed in a vitrified, solid glass rod using laser ablation. The Examiner's assertion that, after one such elongated channel has been formed in the preform, it becomes a "porous preform" is inaccurate, especially based on Applicants' specification, and is based on an unreasonable interpretation of a common term of art.

However, in the interest of expediting the prosecution of this case, Applicants propose amending independent claim 15 to further clarify the meaning of "porous preform." As amended, independent claim 15 would recite, in part, "before

consolidation of the porous preform, forming a pattern of holes extending through the porous preform along the longitudinal direction, wherein said pattern of holes is formed by drilling the porous preform.” As a result, even under the Examiner’s interpretation of “porous preform,” Jakobsen does not teach or suggest the features of independent claim 15 because it does not disclose drilling “before consolidation of the porous preform.” See Applicants’ Specification at page 4, line 23-page 5, line 22 (discussing vitrified glass rods disclosed in Jakobsen and problems resulting from the hardness of the glass). Furthermore, the Examiner’s additional citation of Fogliani fails to cure the deficiencies of the primary reference.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of amended independent claim 15 under 35 U.S.C. § 103(a).

Moreover, claims 16-20, 22, and 24 depend from independent claim 15 and, thus, contain all the elements and limitations thereof. Accordingly, dependent claims 16-20, 22, and 24 are allowable at least due to their corresponding dependence from independent claim 15.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application, entry of the claim amendments, and the timely allowance of the pending claims.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6435.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 24, 2010

By: _____

Benjamin D. Bailey
Reg. No. 60,539